(9)

IN THE

Supreme Court of the United States

OCTOBER TERM, 1942.

No. 673

CHARLES P. BOUCHER and
BOUCHER INVENTIONS, LTD.,
Petitioners,

v.

JOSEPH G. SOLA and
SOLA ELECTRIC COMPANY,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

J. Bernhard Thiess,
Sidney Neuman,
B. Gordon Aller,
77 W. Washington St.,
Chicago, Ill.,
Leslie W. Fricke,
1237 Monadnock Bldg.,
Chicago, Illinois.,
Counsel for Respondents.

MC CORMICK AND HENDERSON, INC.

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Statement.

The controversy at bar arises out of a conflict between rival inventors as to priority of invention. The contest originated as an interference in the Patent Office where both the Patent Office Examiner of Interferences and the Board of Appeals found in favor of respondent Sola[1]

[1] Petitioners apparently have no quarrel with the decisions of the Patent Office. They attempt to avoid their effect as follows (Petition p. 4):

> "There was no determination by the Patent Office of the actual date of invention by Sola or by Boucher."

(R.A. 204, 210[2]). Thereafter petitioners filed their action in the United States District Court for the District of Columbia under Revised Statutes Section 4915 (35 U. S. C. A. Sec. 63) where the same issues were tried. The decision was again in favor of Sola (35 F. Supp. 504) and that decision was affirmed by the Court of Appeals for the District of Columbia (131 F. (2d) 225). Petitioners now seek further review.

Concurrent Findings of Fact Not Reviewable.

From the outset, petitioners are confronted with the hurdle that four lower tribunals in four consecutive decisions have found the issues against them. The trial Court (Bailey, J.) found as a fact that Respondent Sola was the first to conceive and the first to reduce to practice and therefore the prior inventor (Finding of Fact No. 14, P.A. 16). The Court of Appeals refused to disturb this finding. This Court has said repeatedly that if concurrent findings of fact of the courts below are not shown to be plainly erroneous or unsupported by evidence, they will be accepted as a conclusive basis for decision. *Virginia Railway Co.* v. *System Federation No. 40, et al.*, 300 U. S. 515; *Page, Trustee* v. *Arkansas Natural Gas Corp.*, 286 U. S. 269. We believe the petition in this case presents fact questions only.

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[2] The pertinent portions of the record are contained in the appendices to the briefs of the parties in the Court below which by stipulation constitute the record for purposes of this petition. For convenience Petitioners' Appendix will be referred to as P.A. and Respondents' as R.A.

Points Presented by the Petitioners.

The questions this Court is asked to review are stated on page 2 of the Petition under the title "Questions Presented." These form the basis for the "Specification of Errors" listed in the Petition (page 9). Taken together they show clearly that petitioners' only complaint of the opinion below is that the Court considered improper evidence in arriving at its conclusions, and that it ruled against the admission of evidence not previously submitted to the Patent Office, both of which actions petitioners contend reverse the law "as previously established." A reading of the majority opinion (per Justice Rutledge) in the light of the record discloses that petitioners are entirely mistaken in their contentions.

POINT I.

OPINION BELOW DOES NOT REVERSE ESTABLISHED LAW.

NO NEW NUNC PRO TUNC DOCTRINE ASSERTED.

The invention in issue relates to a transformer for neon and other luminous tubes containing means for preventing the establishment of a destructive overload current through a secondary coil section should it become short circuited for a few hours. At the trial Sola, admittedly first to conceive, introduced in evidence a model of his invention, Exhibit 5, built and successfully tested in 1933. Petitioners protested. They questioned the sufficiency of the 1933 test (of 15 minutes' duration) and insistently demanded that Exhibit 5 be subjected to a further test (P.A. 60). Sola, in view of the insistent demand, consented to a further test and for six hours Exhibit 5, then many years old, operated with complete success.[3]

[3] By agreement the test was run during an afternoon when the court was not in session (Finding of Fact No. 16, P.A. 16).

The notes of this test showing operating and other data were offered in evidence by Sola. Upon demand of counsel for petitioners, these notes were introduced in evidence as Petitioners' Exhibit BC (P.A. 78).

The Court's consideration of the test, which was made only upon Petitioners' continued and persistent demand and which is in evidence as a petitioners' Exhibit, is now made the basis for the Petition, as constituting a reversal of "established" law and a *nunc pro tunc* reduction to practice. The record supports neither proposition. Nor can they find support in law.

(a) Established Law Neither Unsettled Nor Reversed.

Petitioners present objection to the test made during the trial and their then insistent demand that such test should be made can hardly be reconciled. It would appear that the only reason for such objections now is that lacking other and more substantial grounds for certiorari, Petitioners are compelled to use the grounds stated as the only ones available. They do not warrant the granting of the writ.

By any true analysis it must be apparent that the reasons assigned for review stated in the Petition deal only with a consideration of facts and the application of rules of evidence. Apart from the camouflage which surrounds it, the only point that can be spelled out of Question I (Petition page 2) is that Petitioners object to the probative effect given by the Court to the evidence introduced by them and adduced from the test made upon their own insistent demand. We point out that such evidence could serve only to negative or substantiate the operativeness of the device first tested in 1933. The Court of Appeals recognized that fact and used the evidence accordingly.

In stating the question, however, petitioners charge that the Court in so giving it probative force "unsettled" and

"reversed" the law as previously declared. Nothing presented in the petition substantiates that charge. On the other hand the rules of this Court required its admission and its decisions authorized its use. Supreme Court Rule 16 provides as follows:

> "In all cases of equity or admiralty jurisdiction, heard in this court, no objection to the admissibility of any deposition, deed, grant, or other exhibit found in the record as evidence shall be entertained, unless such objection was taken in the court below and entered of record. Where objection was not so taken the evidence shall be deemed to have been admitted by consent."

Wigmore affirms the general application of this rule:

> "(3) A failure to object at one trial precludes the opponent at any *subsequent trial* from further objection, for the reason and to the extent that a failure to object before the first trial would have precluded him. And of course no objection at all will be heard when made for the first time in the *court of appeal.*"
>
> *Wigmore on Evidence*, 3rd Ed. Sec. 18 (3), p. 330.

No objection was made to the evidence by Petitioners at the trial. On the contrary it was they who insisted that the evidence be taken and introduced it in evidence. Having formerly insisted upon its production, and made the evidence their own, they cannot now question its competency. Professor Wigmore declares (Wigmore on Evidence, 3rd Ed. Sec. 18, p. 321):

> "The initiative in excluding improper evidence is left entirely to the opponent,—so far at least as concerns his right to appeal on that ground to another tribunal. The judge may of his own motion deal with offered evidence; but for all subsequent purposes it must appear that the opponent invoked some rule

of Evidence. A rule of Evidence not invoked is *waived.*"*

In *Diaz* v. *United States,* 223 U. S. 442, the exact point raised here was decided. There the defendant was convicted of homicide, and one of the grounds for appeal was that he had been deprived of his right to meet the witnesses face to face because his conviction for homicide was rested in part upon testimony produced before a Justice of the Peace on his previous trial for assault and battery. The Court disposed of this ground in the following language (page 450):

> "* * * In these circumstances the testimony was rightly treated as admitted generally, as applicable to any issue which it tended to prove, and as equally available to the Government and the accused. *Sears* v. *Starbird,* 78 California, 225, 230; *Diversy* v. *Kellogg,* 44 Illinois, 114, 121. True, the testimony could not have been admitted without the consent of the accused, first, because it was within the rule against hearsay and, second, because the accused was entitled to meet the witnesses face to face. But it was not admitted without his consent, but at his request, for it was he who offered it in evidence. So, of the fact that it was hearsay, it suffices to observe that when evidence of that character is admitted without objection it is to be considered and given its natural probative effect as if it were in law admissible. *Damon* v. *Carrol,* 163 Massachusetts, 404, 408; *Sherwood* v. *Sissa,* 5 Nevada, 349, 355; *United States* v. *McCoy,* 193 U. S. 593, 598; *Schlemmer* v. *Buffalo &c. Ry. Co.,* 205 U. S. 1, 9; *Neal* v. *Delaware,* 103 U. S. 370, 396; *Foster* v. *United States,* 178 Fed. Rep. 165, 176."
>
> cf. *Gering* v. *Leyda,* 186 Fed. 110, 113.

So in the case at bar, Petitioners requested the evidence now complained of and it was received without objection.

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* Emphasis by the author.

The Court below only gave to such evidence "its natural probative effect" and hence did not unsettle or reverse "established" law.[4]

(b) No New Nunc Pro Tunc Doctrine Promulgated.

The conclusion asserted in the Petition that the Court of Appeals declared a new *nunc pro tunc* doctrine as to reduction to practice is also fallacious. Answering Petitioners' oral argument that the now complained of test could not relate back to show that Respondents' invention was reduced to practice in 1933, the Court of Appeals specifically stated (Opinion page 3):

> "Whatever might be true under other circumstances, plaintiff is in no situation to urge this position after demanding and insisting upon the test, and then insisting it continue beyond the agreed time, when the result was not to his liking."

In so holding, the Court was applying a settled rule of evidence. In *Diaz* v. *United States*, 223 U. S. 442, previously cited, this Court in overruling an objection that defendant had been deprived of the right to meet the witnesses face to face, said (p. 449):

> "* * * But this objection overlooks the circumstances in which the record wherein that testimony was set forth was received in evidence."

This Court also cited with approval and quoted (pages 451-2) from *People* v. *Murray*, 52 Michigan, 288, where Judge Cooley ruled on a similar objection as follows:

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[4] The cases cited in the footnote on page 9 of the Petition have no bearing whatsoever on the issues here presented. They represent merely a collection of authorities on reduction to practice but they do show—most significantly—that the facts in each case are determinative.

> "* * * The defendant undoubtedly had a constitutional right to be confronted with his witnesses. He waived that right in this case, apparently for his own supposed advantage and to obtain evidence on his own behalf. It would have been a mere impertinence for the court to have interfered and precluded this stipulation being acted upon. But it would have been more than an impertinence; it would have been gross error. And it would be palpable usurpation of power for us now to set aside a judgment for a neglect of the court not at the time complained of, but in respect to something where any other course would have been plain error."

Petitioners may have had the right to exclude the complained of evidence had Respondents offered it as part of their case but having themselves insisted that it be presented they cannot now object to it.

The evidence of the successful 1940 test was used by the Court below as confirmatory of other evidence establishing a reduction to practice in 1933. In the light of the circumstances in which the complained of evidence was adduced and received by the Court, the confirmatory probative value given thereto does not constitute a declaration of a new doctrine of *nunc pro tunc* reduction to practice.

POINT II.

COURT OF APPEALS HAS NOT UNSETTLED OR REVERSED THE RULES OF EVIDENCE IN 4915 ACTIONS.

This point is *moot,* as clearly appears from the Opinion. We call attention to the fact, however, that as this question is presented in the petition (Question 2 of Questions Presented, Petition pages 2-3), it misstates the issue. No new rule of law is set forth in the Court's decision.

The majority of the Court were of the opinion that in failing to offer their pertinent Exhibit AR in the Patent Office Interference, Petitioners were guilty of such suppression of this evidence as required denial of its admission in the District Court in the 4915 action (Rev. Stats. Sec. 4915, 35 U. S. C. A. Sec. 63). Authority for such holding is legion. *Barrett Co.* v. *Koppers,* 22 F. (2d) 395; *Greene* v. *Beidler,* 58 F. (2d) 207; *Dowling* v. *Jones,* 67 F. (2d) 537.

The District Court (Justice Bailey) admitted the evidence following the decision in *Wright* v. *Runge,* 31 F. Supp. 844. The majority of the Court of Appeals were apparently of the opinion that the facts in this case more nearly paralleled the facts in *Barrett Co.* v. *Koppers, supra,* and cases similar. It is simply a matter of judgment in the light of all of the evidence and the circumstances of each case.

In any event it can afford no ground for the granting of the writ for the Court's remarks on this point were not necessary in the decision of the case. The opinion states (pages 3 and 4):

> "* * * We have added these views, first, to indicate that if the evidence concerning Sola's reduction to practice were less conclusive than it is, still there would be serious question whether the record contains admissible evidence to show that Boucher reduced the invention to practice prior to the filing of Sola's application. We have added them also, though not strictly necessary for decision of the cause, to avoid by admonition, if possible, the necessity for making decision on such a ground in another case, in which the consequences might be more serious."

PETITION PRESENTS NO QUESTION OF PUBLIC IMPORTANCE.

We have demonstrated that the Petition seeks a review of evidentiary facts and contains no question of public importance which requires the granting of certiorari, *General Talking Pictures Corp.* v. *Western Electric Co. et al.*, 304 U. S. 175, 178. This Court frowns upon such petitions. In *Southern Power Co.* v. *North Carolina Public Service Co., et al.*, 263 U. S. 508, the Court dismissed a writ after it had been granted because on the argument it developed "that the controverted question was whether the evidence sufficed to establish actual dedication of petitioner's property to public use—primarily a question of fact."[5] A similar question of fact, *i.e.*, actual reduction to practice of an invention is presented in this case.

In *United States* v. *Johnston*, 268 U. S. 220, Mr. Justice Holmes stated (page 227):

> "* * * We do not grant a certiorari to review evidence and discuss specific facts."

That is exactly what the present petition seeks to do. Obviously, no matter of public importance is presented. This is emphasized by the fact that all tribunals which have passed upon this controversy found in favor of Respondents.

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[5] The Court there impliedly admonished counsel for failing to clearly present the controverted question in the petition and thus wasting the Court's time.

CONCLUSION.

It is respectfully submitted that no grounds for the granting of certiorari being present, the Petition should be denied.

Respectfully submitted,

J. Bernhard Thiess,
Leslie W. Fricke,
Sidney Neuman,
B. Gordon Aller,
Counsel for Respondents.